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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,531	09/27/1999	ODD N. ODDSEN JR.	3757.3002	1718

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EXAMINER

WOOD, KIMBERLY T

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/406,531

Applicant(s)
Oddsden Jr.

Examiner
Kimberly T. Wood

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-78 is/are pending in the application.
- 4a) Of the above, claim(s) 36-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 18 6) ☐ Other:

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This is the fourth office action for serial number 09/406,531, entitled Configurable Mount in response to Amendment D filed on March 11, 2002.

Election/Restriction

Claims 37-40, 44-49, 52 and 55-62 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 9.

Claims 36, 50, 63, 67, 72, and newly submitted claims 74-78 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims have been amended to include the limitations "a plurality of attachment components adapted to be assembled into a plurality of attachment means each of a different configuration for attaching said shaft holder to the surface at least one of said attachment means comprising the assembly of less than all of said plurality of attachment components.". The applicant has attempted to make the claims generic by adding this limitation to the claimed language but, the examiner believes the applicant has narrowed the claim language to include all of the species except for the species II, which applicant elected in paper no. 9. The applicant has claimed that "the assembly of less than all of said plurality of attachment components." The examiner has interpreted the added limitation to mean that at least one element would not be included in the attachment means. Therefore, the applicant has eliminated the species II originally elected since the attachment means has to include all of the elements of the species as shown in figures 2,3,

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10A-10B, 11A-11B, 12A-12C or the claims are directed to a new species that has not been elected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36, 41-43, 50-53, 54, 63-78 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant argues that all of the independent claims (36, 50, 63, 67, and 72) are generic. The examiner would like to point out that for the reason discussed above the claims are directed toward a non-elected species only and therefore can not be generic. In addition, claims 50 and 67 can not be generic, since species III (figure 8) does not include a first member having a flange or a second member having a flange.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36, 63, 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has included the limitations "provided that all of said plurality of attachment means at least includes said shaft holder". The plurality of attachment means should not include

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the shaft holder because the shaft holder has not been disclosed as an attachment means in the specification. The shaft holder has been claimed as a separate element from the attachment means previously within the claim.

The claims are replete with indefinite and ambiguous language that the examiner can not determine what is included in the limitations and what is excluded from the limitations.

Response to Arguments

Applicant's arguments filed March 11, 2002 have been fully considered but they are not persuasive. .

The applicant attempts to argue that the added limitations including "a plurality of attachment components adapted to be assembled into a plurality of attachment means each of a different configuration for attaching said shaft holder to the surface at least one of said attachment means comprising the assembly of less than all of said plurality of attachment components." includes the limitations of the other non-elected species in the application therefore, making the claims generic. The examiner traverses this argument because the limitation "at least one of said attachment means comprising the assembly of less than all of said plurality of attachment components" results in trying to make the invention that was originally claimed as an apparatus into a claim that is directed to a kit. An apparatus can only be claimed including one species wherein within this application the species has to consist of all of the elements of elected

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Species II. The applicant attempts to claim the apparatus of Species II and in the same instance have an apparatus of one of the non-elected Species simultaneously. This would cause the claim to be incorrect because instead of claiming an apparatus the applicant is claiming a kit which is a different and distinct invention for the applicant's elected species II. In addition, the applicant has added the limitation "provided that all of said plurality of attachment means at least includes said shaft holder", this confuses the examiner because the examiner can not determine whether or not the shaft holder is provided or is not provided since the language makes it seem that if the shaft is provided **than** attachment means is provided but, what if the shaft holder is not provided then what? The applicant has presented claims that the examiner can not determine what limitations are included in the application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax numbers for filing formal papers to the Group receptionist are (703) 305-3597.

Kimberly Wood
June 3, 2002


KIMBERLY WOOD
PATENT EXAMINER
Primary Examiner